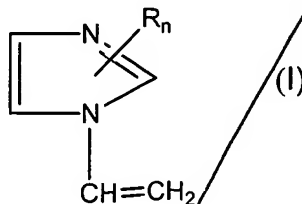


- B2
A2
Contd
- (D) addition products of 1-vinylimidazole monomers of formula (I):



in which the radicals R independently represent H or a linear or cyclic, saturated or unsaturated C₁-C₆ alkyl radical,

n is an integer ranging from 1 to 3,

with polyalkylenepolyamines (A)(i) to (A)(ix);

- (E) amino acid polymers with a basic side chain; and
(F) crosslinked derivatives of the polymers (A)(i) to (A)(ix), (B), (C), (D) and (E);

wherein said polyamino polymer is present in an amount effective to inhibit light-induced peroxidation of proteins, protein derivatives, and lipids.

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I. Status of the Claims

Claims 1-44 are pending. Claims 29-32, 36, and 38-44 are withdrawn from consideration. Claims 1-28, 33-35, and 37 stand rejected. Claim 37 has been amended. Support for the amendment to claim 37 be found throughout the specification and claims, e.g., at page 20, lines 7-15; page 22, lines 4-17; and the tests set forth at pages 34-41. No claims have been cancelled by this response.

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II. Wolf in view of Fanchon

The Office has maintained the rejection of claims 1-23, 27, 28, 33-35, and 37 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,449,519 ("Wolf") in view of U.S. Patent No. 5,679,374 ("Fanchon") for the reasons set forth at pages 2-3 of the Office Action. Applicants respectfully traverse this rejection for the reasons of record, as well as for the additional reasons set forth below.

In response to Applicants' arguments that Wolf fails to provide the guidance necessary to choose Applicants' claimed polyamino polymers, the Office has argued that "dendrimers are preferred for their multiple sites of complexation with salicylic acid, providing stability to the composition at pH's above 3." However, this argument misses the point, because there is no motivation to combine Applicants' claimed polyamino polymers with a nanopigment. As already pointed out in the arguments of record, Wolf does not teach nanopigments at all, but merely teaches that pigments may optionally be used. While Fanchon has been cited by the Office to cure the deficiency of Wolf, Fanchon merely teaches generally that pigments and nanopigments may optionally be used in the compositions of Fanchon. However, no suggestion at all is supplied which would provide the requisite motivation to combine nanopigments with Applicants' claimed polyaminopolymers.

Motivation must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Applicants submit that the combination of Wolf and Fanchon fails to provide clear and particular motivation to make all the necessary choices required to arrive at the claimed composition. At best, it may have

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been obvious to try every possible combination of species falling within the scope of the Wolf/Fanchon combination. However, as the Office is well aware, obvious to try is not the standard for determining obviousness. See M.P.E.P. § 2145(X)(B). Therefore, as the requisite motivation has not been provided, the rejection should be withdrawn for this reason alone.

In addition, the Office has argued that "[a]s to applicant's intended use, such limitations are not considered patentable in composition claims during prosecution before the Office." See Office Action, p. 3. In a telephone conversation on October 2, 2001, the Examiner confirmed that this argument was directed to claim 37 and Applicants' corresponding remarks regarding claim 37 found at pages 4-5 of the Response filed March 29, 2001. However, amended claim 37 recites "[a]n antioxidant composition comprising at least one polyamino polymer . . . wherein said polyamino polymer is present in an amount effective to inhibit light-induced peroxidation of proteins, protein derivatives, and lipids." This functional language makes it more clear that claim 37 recites an inventive composition neither taught nor suggested in the prior art. Wolf, the primary reference used to reject the claims, does not even mention antioxidants, and therefore its composition would hardly be considered by one of ordinary skill in the art to be an antioxidant composition, let alone to contain a polyamino polymer present in an amount effective to inhibit light-induced peroxidation of proteins, protein derivatives, and lipids. Fanchon does not mention the polyamino polymers of the claimed invention, and thus does not teach such polyamino polymers present in an amount effective to inhibit light induced peroxidation. Thus, neither Wolf nor Fanchon, taken separately or in combination, provides any teaching or suggestion of an

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antioxidant composition comprising at least one polyamino polymer present in an amount effective to inhibit light-induced peroxidation.

In view of the above, Applicants request that the rejection be withdrawn.

III. Wolf et al. in view of Fanchon et al. and Garrison et al.

Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf as applied to claims 1-23, 27, 28, 33-35, 37 above, and further in view of U.S. Patent No. 5,569,651 ("Garrison").

As an initial matter, Applicants' representative verified with the Examiner in a telephone conversation on or about October 4, 2001, that the rejection of claims 24-26 was intended to include the Fanchon reference, as set forth in the Office Action of December 13, 2000. Thus, Applicants' following arguments are directed to the combination of Wolf in view of Fanchon, and further in view of Garrison.

Claims 24-26 depend from claim 1, and therefore also require the claimed polyamino polymer. Garrison et al. fails to provide the missing motivation needed for the Wolf and Fanchon combination. In fact, Garrison et al. is completely silent with respect to such a polyamino polymer. Therefore, claims 24-26 are allowable for at least the reasons argued above for claim 1. Accordingly, Applicants respectfully request withdrawal of this rejection.

IV. Objection to the Specification

The Office objected to Applicants' specification because no application numbers were provided for the applications cited in the first paragraph of page 1. The

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specification has been amended to include the appropriate application numbers.
Accordingly, Applicants request that the objection be withdrawn.

V. Information Disclosure Statement

The Office has indicated that the specific abstracts were not specified for Chemical Abstracts submitted along with the Information Disclosure Statement filed March 29, 2001. A new PTO 1449 which sets forth the specific abstracts to be considered is being submitted herewith.

VI. Conclusion


In view of the foregoing remarks, Applicants submit that this claimed invention is not rendered obvious in view of the prior art references cited against this application. Applicant therefore request the entry of this Response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 16, 2001

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